

DETAILED ACTION

1. The following is a final office action upon examination of application number 10/735018. Claims 1 and 3-53 are pending and have been examined on the merits discussed below.

Response to Arguments

2. Applicant's arguments, filed 12/14/09, with respect to rejections under 35 USC 103 have been fully considered and are persuasive. The rejection under 35 USC 103 of the claims has been withdrawn.
3. Applicant's arguments filed with respect to previous rejections under 35 USC 101 of claims 40-53 have been fully considered but they are not persuasive. Examiner points out claims 40-49 are system claims and claims 50-53 are claims directed to an article of manufacture, specifically computer readable media. Applicant has submitted arguments regarding these claims in view of *In re Bilski*. Only claims which are directed to a method are evaluated based on *In re Bilski*. The claims are not statutory under 35 USC 101 since the system contains no structure and the computer readable media include signals. See rejections under 35 USC 101 below.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 40-53 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 40-49 are rejected as being directed toward non-statutory subject matter because they are software per se. Claim 40 recites “user interface and question optimization module” as well as other elements that appear to be software modules or computer programs. As drafted, the claim fails to define any structural and functional interrelationships between the software per se and other elements of the invention that permit the software’s function to be realized. (See MPEP § 2106.01 Section I).

Claims 50-53 are rejected as being directed toward non-statutory subject matter because they are software per se. Claim 50-53 recites “computer readable medium”. The specification, paragraph 0088, page 27, states the medium can include, among other things, satellite transmission, known as signals. Signals are not statutory under 35 USC 101. To properly determine whether a claimed invention complies with the statutory invention requirements of 35 U.S.C. 101, USPTO personnel must first identify whether the claim falls within at least one of the four enumerated categories of patentable subject matter recited in section 101 (i.e., process, machine, manufacture, or composition of matter). A claim directed to a signal per se does not appear to be a process, machine, manufacture, or composition of matter.

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When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See >Diamond v.< Diehr, 450 U.S. *>175,< 185-86, 209 USPQ *>1,< 8 (noting that the claims for an algorithm in Benson were unpatentable as abstract ideas because “[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.”). MPEP 2106.01 [R-6]

Allowable Subject Matter

6. Claims 1 and 3-39 allowed.

Applicant’s reply makes evident the reason for allowance, satisfying the record as a whole as required by rule 37 CFR 1.104(e). In this case, the substance of applicant’s remarks filed on 2/14/09 point out the reason claims are patentable over the prior art of record (see MPEP 1302.14).

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHNNA R. LOFTIS whose telephone number is (571)272-6736. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on 571-272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3624

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Johnna R Loftis/
Examiner, Art Unit 3624